IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

PHOTOGRAPHIC ILLUSTRATORS CORPORATION, Plaintiff,	)	
v.	)	CIVIL ACTION NO.: 1:14-cv-14256
INTERNATIONAL LIGHTING CORP. D/B/A INTERLIGHT, Defendant.	)	**LEAVE TO FILE GRANTED ON FEBRUARY 23, 2015**

REPLY OF INTERNATIONAL LIGHTING CORP.
IN SUPPORT OF ITS MOTION TO DISMISS

PIC's Lanham Act claim is precluded by the Copyright Act. PIC (willfully) ignores the critical distinction that it cannot allege that Interlight sold any of PIC's goods, which are *photographs*. PIC only alleges that Interlight used its photographs in an attempt to sell *light bulbs*. Interlight, as a seller of lighting supplies, does not sell photographs. Since Interlight is not alleged to have sold PIC's goods, PIC has no claim for relief under the Lanham Act.

A. The Complaint Fails to State a Claim Under 43(a)(1)(A)

The Supreme Court decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.* squarely forecloses PIC stating a claim for relief under the Lanham Act. 539 U.S. 23, 37 (2003). In *Dastar*, Fox produced a TV series based on General Eisenhower's book about the Allies' victory, entitled *Crusade in Europe*. After Fox let the copyright lapse, Dastar bought a copy of the series, re-edited it and sold it under a new title as its own product. Fox sued Dastar, claiming that the sale of the rival company's videos without credit to the TV series constituted "reverse passing off", the misrepresentation of another's goods as one's own, in violation of the Lanham Act.

The Supreme Court found that Section 1125(a) of the Lanham Act prohibits use in commerce of any word, term, name, symbol or device that is likely to cause confusion or mistake as to the origin of another's *goods*. The deciding factor for the *Dastar* Court was how the term "origin" is interpreted.

> In sum, reading the phrase "origin of goods" in the Lanham Act in accordance with the Act's common-law foundations (which were *not* designed to protect originality or creativity), and in light of the copyright and patent laws (which *were*), we conclude that the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept or communication embodied in those goods. . . . To hold otherwise would be akin to finding that §43(a) created a species of perpetual patent and copyright, which Congress may not do.
> 539 U.S. at 37.

Because Dastar was the "origin" of the physical products it sold as its own, Fox could not prevail on its Lanham Act claim. The phrase "origin of goods", as used in the Lanham Act, is incapable of connoting the person or entity that originated the ideas that the "goods" embody or contain. "The consumer typically does not care about such origination, and §43(a) should not be stretched to cover matters that are of no consequence to purchasers." *Dastar*, 539 U.S. at 24.

In an attempt to defeat Interlight's Motion, PIC repeatedly refers to the statement in *Dastar* that a Lanham Act claim would be sustained if Dastar had simply bought the videotapes and merely repackaged them as its own. This reference is irrelevant to the instant case. Interlight did not buy and resell PIC photos as its own. Plainly, Interlight has never sold photos. Further, the three cases that PIC contends support its argument are inapposite. These cases - *Cable v. Agence France Presse*; *Defined Space, Inc. v. Lakeshore E., LLC*; and *Levine v. Landy* – have one critical difference. All three involve the reproduction, licensing or sale of photos themselves, whether online or in a book. Cable alleged that Agence France Press copied and distributed his photos as the purported licensor, in an attempt to sub-license sales of the photos to third-parties. *Levine* involved the sale of a book containing plaintiff's photos and *Defined Space* concerned plaintiff licensing photos to defendant. PIC cannot state a claim under the Lanham Act because Interlight did not appropriate its photos and sell them as its own.

The Court in *Personal Keepsakes, Inc. v. personalizationmall.com*, 2012 U.S. Dist. LEXIS 15280, *17 (N.D. Ill) also distinguished *Cable* and *Defined Space* as involving defendants' re-selling plaintiff's products as their own. In *Personal Keepsakes*, plaintiff sold gifts personalized with poetry verses and defendants sold similar items on their websites. Plaintiff sued, alleging that defendants took poems from its products and put them on their competing products. In addition to claims for copyright infringement and violation of the DMCA, plaintiff alleged that defendants violated the Lanham Act by misappropriating its copyrighted materials and re-packaging them for sale as if they were defendants' products. After an in-depth analysis of *Dastar*, the court rejected plaintiff's contention that defendants merely re-packaged and re-sold its goods. Defendants sold different personalized gifts and at times incorporated plaintiff's poems into their own products. They did not sell plaintiff's tangible products as their own. Applying *Dastar*, it dismissed the Lanham Act claim because plaintiff is not the "origin" of the product.

In *Cyber Websmith v. American Dental Ass'n.,* 2010 U.S. Dist. LEXIS 80206 (N.D. Ill), plaintiff alleged that defendants copied photos from its website to use in direct competition with its business of providing website design to dental practices. While plaintiff asserted a reverse passing off theory, that defendants were misrepresenting the plaintiff's goods as their own, the court held that plaintiff's claims were for alleged misappropriation of its copyrighted works. The court rejected the argument that plaintiff had alleged extra elements, noting that consumer confusion and deception are inherently present in any copyright action and are thus not considered extra elements that qualitatively alter the nature of a claim.

In the instant case, PIC photos constitute "communicative products" Protected by copyright. 539 U.S. at 24. Interlight is not alleged to have sold any PIC photos. Interlight, or its suppliers, are the origin of the physical products it sells, light bulbs. Thus, PIC's claims sound solely in copyright law. *See Steele v. Turner Broad. Sys., Inc.*, 607 F.Supp.2d 258, 262 (D. Mass. 2009) (Lanham Act claim dismissed because plaintiff was not producer of tangible goods distributed by defendant). As the Supreme Court emphasized in *Dastar*, courts should be reluctant to contribute to the misuse or overextension of trademark and related protections into areas traditionally occupied by patent or copyright. 539 U.S. at 34. In *Boston International Music, Inc. v. Austin*, 2003 U.S. Dist. LEXIS 16240, *2 (D. Mass.), the court granted defendants' motion to dismiss the Lanham Act claim because plaintiff's claim was sufficiently covered by copyright law. It declined to construe §43(a) to require attribution to plaintiff where defendants were the origin of the product they reported and sold, citing *Dastar*.

B. PIC Cannot State a Cause of Action Under Section 1125(a)(1)(B)

PIC's attempt to shoehorn what is essentially a copyright infringement claim into the false advertising section of the Lanham Act cannot succeed. In an attempt to save its Lanham Act claim, PIC contends that its false authorship claim constitutes false advertising under §1125(a)(1)(B), relying on the faulty argument that *Dastar* left this option open. Many courts have found that the holding in *Dastar*, and its reasoning, also applies to authorship claims brought under this section, which prohibits misrepresentations going to "the nature, characteristics, qualities, or geographic origin of … goods". In *Antidote International Films, Inc. v. Bloomsbury Publishing, TLC*, 467 F.Supp.2d 394, 400 (S.D.N.Y. 2007), the court explained that the holding in *Dastar* that the word "origin" refers to producers rather than authors, implies that the words "nature, characteristics and qualities" cannot be read to refer to authorship. "If authorship were a characteristic or quality of a work, then the very claim *Dastar* rejected under §43(a)(1)(A) would be available under §43(a)(1)(B)." The Ninth Circuit in *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137, 1144 (9th Cir. 2008) affirmed dismissal of a §43(a)(1)(B) claim alleging that the defendant misrepresented that it had properly licensed the songs it was selling. It held that "the nature, characteristics and qualities" of a product under the Lanham Act "are more properly construed to mean characteristics of the good itself," not things like copyright licensing status. To do otherwise would create overlap between the Lanham Act and Copyright Act. The Federal Circuit reached the same conclusion in *Baden Sports, Inc. v. Molten USA, Inc.*, 556 F.3d 1300, 1308 (Fed. Cir. 2009), *cert. denied*, 558 U.S. 822, 13 (2009); *see also Personal Keepsakes, Inc.*, 2012 U.S. Dist. LEXIS 15280, *14-16; *Lapine v. Seinfeld*, 2009 U.S. Dist. LEXIS 82304, *45-46 (S.D.N.Y.) *ZS Assocs. v. Synygy, Inc.*, 2011 U.S. Dist. LEXIS 55711, *28 (E.D. Pa.); *Sidem, S.A. v. Aquatech Int'l Corp.*, 2010 U.S. Dist. LEXIS 62357, *22-25 (W.D. Pa.)). Since authorship cannot be a "nature, characteristic or quality" under §43(a)(1)(B), PIC's Lanham Act claim must be dismissed.

C. CONCLUSION

For the foregoing reasons, Interlight respectfully requests that this Court enter an order dismissing Count III and for such further relief as it deems proper.

Respectfully submitted,

INTERNATIONAL LIGHTING CORP.,
D/B/A INTERLIGHT, By its counsel,

Dated: February 27, 2015

/s/ Russell Pollock

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CERTIFICATE OF SERVICE

I certify that this document is being filed through the Court's electronic filing system, which serves counsel for other parties who are registered participants as identified on the Notice of Electronic Filing (NEF). Defendant is being served on the date of electronic filing.

/s/ Russell Pollock
Russell Pollock